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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,861	12/02/2003	Jerome Witmann	5378	1584

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SHOEMAKER AND MATTARE, LTD  
10 POST OFFICE ROAD - SUITE 110  
SILVER SPRING, MD 20910

EXAMINER
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HENEGHAN, MATTHEW E

ART UNIT	PAPER NUMBER
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2139

MAIL DATE	DELIVERY MODE
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02/08/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/724,861

Applicant(s)

WITMANN, JEROME

Examiner

Matthew Heneghan

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. In response to the previous office action, Applicant has amended claims 1, 2, and
4. Claims 1-4 have been examined.

### ***Drawings***

2. The drawings were received on 29 November 2007. These drawings are acceptable.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: the term "the API code" in line 3 lacks proper antecedent basis. It is suggested that this be corrected by amending the preamble to read "A method of protecting application program software executing API code including:" Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,401,137 to Wolczko et al.

Wolczko discloses a virtual call system in which inline code may be copied (by a tracer function) into an inline cache for execution up to the limit of an upper bound. Beyond that bound, the code must be executed from its original location (see column 6, lines 1-32 and column 7, lines 33-46). The code may be an application (see column 1, lines 61-65).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,401,137 to Wolczko et al.

Regarding claim 2, Wolczko does not explicitly state that the inline cache is being stored in RAM of the CPU, but simply that it is in main memory (see column 5, lines 20-21).

Official notice is given that it is well-known in the art to store caches in RAM, for fast access.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to store the inline cache in the CPU's RAM area, as is well-known in the art.

Wolczko also discloses the use of 8-instruction limits, rather than 16; however, this boundary is implementation-specific (see column 8, lines 18-24) and it would be obvious to one of ordinary skill in the art to use a 16 instruction boundary depending upon the specific design considerations.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,401,137 to Wolczko et al. as applied to claim 1 above, and further in view of U.S. Patent No. 7,080,257 to Jakubowski et al.

Wolczko does not explicitly state what kinds of applications are being run on the system.

Jakubowski discloses the use of in-lining in the context of security programming (see abstract and column 13, lines 27-32).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to use the invention of Wolczko in a security program, as per Jakubowski.

***Allowable Subject Matter***

7. Claim 4 would be allowable if rewritten to overcome the objection to claim 1 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: Applicant's arguments regarding claim 1 (see Remarks, filed 29 November 2007) are persuasive when applied to claim 4; the combination of Wolczko and Cao would not work in the claimed manner. No other art could be found that would render the claim unpatentable.

### ***Response to Arguments***

9. Applicant's arguments filed 29 November 2007 have been fully considered but they are not persuasive.

Though Wolczko's functionality significantly differs from that of Applicant's disclosed invention, the invention as claimed does not preclude the manner in which Wolczko inserts instructions. The consideration of boundary conditions makes the return to the next instruction of the code inherent.

It is noted, however, that, when considered in light of amended claim 1, Wolczko teaches away from the additional features of claim 4 to the extent that claim 4 is no longer obvious.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached at (571) 272-4063.

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**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Matthew Heneghan/

Primary Patent Examiner, USPTO AU 2139

February 6, 2008